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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,238	12/05/2001	James G. Shanahan	D/A1320	8310

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/683,238	Applicant(s) SHANAHAN ET AL.	
	Examiner Laurie Ries	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 16-18 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-18 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for Continued Examination, filed 17 April 2006, to the original application, filed 5 December 2001.
2. The rejection of claims 1-3, 11, and 21-22 under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", and Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", has been withdrawn as necessitated by amendment and newly found prior art.
3. The rejection of claims 4-6 and 12-14 under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", and Wang (U.S. Publication 2002/0023215 A1) has been withdrawn as necessitated by amendment and newly found prior art.
4. The rejection of claims 8-9, 16-17, and 23-24 under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz

'987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", and Goodisman (U.S. Publication 2002/0069223 A1) has been withdrawn as necessitated by amendment and newly found prior art.

5. The rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", and Keith (U.S. Publication 2002/0032672 A1) has been withdrawn as necessitated by amendment and newly found prior art.

6. The rejection of claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", Wang (U.S. Publication 2002/0023215 A), and Goodisman (U.S. Publication 2002/0069223 A1) has been withdrawn as necessitated by amendment and newly found prior art.

7. Claims 1-6, 8-14, 16-18, and 21-24 are pending. Claims 7, 15, and 19-20 have been cancelled. Claims 1, 11, and 21 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 8-9, 11-14, 16-18, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", and Reber (U.S. Patent 5,986,651).

As per claims 1, 11, and 21, Horowitz '647 discloses a system, article of manufacture and method for enriching (or annotating with a predefined theme) the content of a document by enriching at a meta-document server the identified document content using a set of document service requests (See Horowitz '647, Column 10, lines 8-27) and making the enriched document content available at the server (See Horowitz '647, Column 11, lines 39-40).

Horowitz '647 does not disclose expressly a personality identifier associated with a database of personalities defining enrichment themes, where the enriching recognizes

and annotates entities in the identified document content related to the enrichment theme of the associated personality.

Horowitz '987 discloses using a topic ID, recorded with a dynamic content organization module, which reads the content (See Horowitz '987, Column 10, lines 41-61) into a database on a computer, and therefore digitally readable, which is associated with a topic, or personality, in a database of topics, or personalities (See Horowitz '987, Column 8, lines 36-67, Column 9, lines 1-5, and Column 10, lines 36-41). Horowitz '987 also discloses a supertopic arrangement containing associated subtopics, which can be used to enrich a document based on the specific supertopic (See Horowitz '987, Column 11, lines 52-67, and Column 12, lines 1-26), and annotating entities in the identified document content related to the associated supertopic (See Horowitz '987, Column 8, lines 52-67 and Column 9, lines 1-29).

Horowitz '647 also does not disclose assigning different personality identifiers depending on what time of year the personality identifier is recorded.

Mockus discloses embedding contextual data into an interactive document. Mockus also discloses that the interactive documents may be related to data that pertains to particular sporting events, such as NASCAR races, which are seasonal events. Mockus discloses specifically, by way of example, an interactive document with embedded data related to a study of truck races included in the 1999 racing season (See Mockus, Pages 183-184, Sections 5-5.1). As sporting events such as NASCAR races include numerous individual events occurring at specific periods of time, it would have been obvious to one of ordinary skill in the art to assign different personality

identifiers, or subtopic ID's, to the document based upon the time of year, which would include the current status of the NASCAR race season. For example, a document annotated in the early part of the NASCAR season, such as February, would contain personality identifiers for the results of races occurring in the early part of the season only. Continuing with this example, a document annotated in the later part of the NASCAR season, such as November, would contain personality identifiers for the final season statistics. The motivation would have been to allow a user to view annotated data including results for races occurring at different times during the NASCAR season (See Mockus, Page 184, "Potential User Interactions").

Horowitz '647 also does not disclose an electronic tag reader including a transmitter and receiver to read an electronic identification tag.

Reber discloses a network navigation device from which electronic identification data may be read, which includes a transmitter and receiver (See Reber, Column 4, lines 45-60, Figure 3, element 56, and Column 7, lines 59-63). Reber also discloses recording context information including a time of year during which data is recorded by the reader (See Reber, Column 14, lines 60-67, Column 15, lines 1-8, and Column 16, lines 29-35). Reber also discloses identifying document content within the reader using the recorded context information (See Reber, Column 7, lines 59-63), and transmitting from the reader the identified document content to a server (See Reber, Column 13, lines 34-50).

Horowitz '647, Horowitz '987, Mockus and Reber are analogous art because they are from the same field of endeavor of embedding data into documents.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the subtopic ID and supertopic ID arrangement of Horowitz '987 with the method of Horowitz '647. The motivation for doing so would have been to determine topic intersections of interest to the user (See Horowitz '987, Column 11, lines 52-56)

At the time of the invention it would also have been obvious to include the seasonal sporting event data of Mockus with the system and method of Horowitz '647 and Horowitz '987. The motivation for doing so would have been to support the highlighting or annotating of a subset of data, such as data specific to a particular racing season, so that the reader may focus attention on these subsets when viewing an enriched or annotated document (See Mockus, Page 184, "Potential User Interactions").

At the time of the invention it would also have been obvious to include the electronic identification tag and reader of Reber with the document enrichment system and method of Horowitz '647, Horowitz '987, and Mockus. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28).

Therefore it would have been obvious to combine Horowitz '987, Mockus, and Reber with Horowitz '647 for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and reducing the

complexity of navigating a collection of documents to obtain the invention as specified in claims 1, 11, and 21.

As per claim 2, Horowitz '647, Horowitz '987, Mockus and Reber disclose the limitations of claim 1 as described above. Horowitz '647 also discloses transmitting the recorded personality ID and the context information to a meta-document server, where the meta-document server identifies the document content, associates the identified document content with the personality ID, and enriches the document content (See Horowitz '647, Figure 8, Figure 9, and Column 11, lines 24-32).

As per claim 3, Horowitz '647, Horowitz '987 and Mockus disclose the limitations of claim 2 as described above. Horowitz '647 also discloses that the meta-document server, upon identification of the document content, associates the personality ID with the identified document content (See Horowitz '647, Figure 8, element 808), that the meta-document server recognizes, with at least a first method, an entity in the document content (See Horowitz '647, Column 8, lines 50-61), that the meta-document server accesses, with at least a second method, a document service using the recognized entity (See Horowitz '647, Column 9, lines 28-63), that the meta-document server annotates the identified document content with output from the document service to define enriched document content (See Horowitz '647, Figure 8, element 810, and Column 10, lines 22-27), and that the meta-document server makes the enriched document content available to a set of one or more users (See Horowitz '647, Column 11, lines 39-40).

As per claims 4 –6 and 8-9, Horowitz '647, Horowitz '987, Mockus and Reber disclose the limitations of claim 1 as described above. Reber also discloses recording the digitally readable ID from an electronic tag with an electronic tag reader (See Reber, Column 4, lines 45-55). Reber also discloses recording the digitally readable ID from embedded data recorded on a hardcopy document with a scanner (See Reber, Column 4, lines 45-55). Reber also discloses that the digitally readable ID may be recorded with a mobile computing device that identifies position coordinates where data is recorded (See Reber, Column 4, lines 24-30, Column 14, lines 60-67, and Column 15, lines 1-8). Reber also discloses that the recorded context information is time information including a timestamp (See Reber, Column 14, lines 60-67, and Column 15, lines 1-8). Horowitz '647, Horowitz '987, Mockus and Reber are analogous art because they are from the same field of endeavor of embedding data into documents. At the time of the invention it would also have been obvious to include the electronic identification tag and reader of Reber with the document enrichment system and method of Horowitz '647, Horowitz '987, and Mockus. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28). Therefore it would have been obvious to combine Reber with Horowitz '647, Horowitz ' for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and

reducing the complexity of navigating a collection of documents to obtain the invention as specified in claims 4 - 6 and 8-9.

Claim 12 is rejected on the same basis as claim 4.

Claim 13 is rejected on the same basis as claim 5.

Claim 14 is rejected on the same basis as claim 6.

Claim 16 is rejected on the same basis as claim 9.

Claim 17 is rejected on the same basis as claim 8.

Claim 18 is rejected on the same basis as claim 6

As per claim 22, Horowitz '647, Horowitz '987, Mockus, and Reber disclose the limitations of claim 21 as described above. Horowitz '647 also discloses transmitting the recorded topic ID and context information to a meta-document server, where the meta-document server identifies the document content, associates the identified document content with the personality ID, and enriches the document content (See Horowitz '647, Figures 8 and 9), where the meta-document server, upon identification of the document content, associates the topic ID, personality ID, with identified document content (See Horowitz '647, Figure 8, element 808), recognizes, with at least a first method, an entity in the document content (See Horowitz '647, Column 8, lines 50-61), accesses, with at least a second method, a document service using the recognized entity (See Horowitz '647, Column 9, lines 28-63), annotates the identified document content with output from the document service to define enriched document content (See Horowitz, Figure 8, element 810, and Column 10, lines 22-270, and makes the

enriched document content available to a set of one or more users (See Horowitz, Column 11, lines 39-40).

Claim 23 is rejected on the same basis as claim 8

Claim 24 is rejected on the same basis as claim 9.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", Mockus ("A Web-Based Approach to Interactive Visualization in Context"), hereafter referred to as "Mockus", and Reber (U.S. Patent 5,986,651) as applied to claim 1 above, and further in view of Keith (U.S. Publication 2002/0032672 A1).

As per claim 10, Horowitz '647, Horowitz '987, Mockus and Reber disclose the limitations of claim 1 as described above. Horowitz '647, Horowitz '987, Mockus and Reber do not disclose expressly providing notification that the enriched document is available. Keith Jr discloses notifying a user regarding updated data (See Keith Jr, Pages 10-11, paragraph 0092). Keith Jr, Horowitz '647, Horowitz '987, Mockus and Reber are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the user notification of updated data of Keith Jr with the enriched document of Horowitz '647, Horowitz '987, Mockus and Reber. The motivation for doing so would have been to push information to users when desired new

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information is entered into the system (See Keith Jr, Page 11, paragraph 0092).

Therefore, it would have been obvious to combine Keith Jr with Horowitz '647, Horowitz '987, Mockus and Reber for the benefit of pushing information to users when desired new information is entered into the system to obtain the invention as specified in claim 10.

Response to Arguments

10. Applicant's arguments with respect to claims 1-6, 8-14, 16-18, and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER